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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/464,997	12/16/99	WATKINS	L 4642

EXAMINER

IM22/0615

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ART UNIT

PAPER NUMBER

1762

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06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/464,997**

Applicant(s)  
**Watkins**

Examiner  
**Katherine A. Bareford**

Art Unit  
**1762**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2001
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Continued Prosecution Application***

1. The request filed on April 30, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/464,997 is acceptable and a CPA has been established. An action on the CPA follows.

The Examiner notes that the application filing fee was provided on June 7, 2001.

2. The Examiner notes that no amendment or request for reconsideration has been provided to the case with the CPA request or at any time since the last rejection of October 30, 2000. As a result, the following rejection duplicates that of October 30, 2000.

***Election/Restriction***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a method of applying, classified in class 427, subclass 243.
  - II. Claims 13-17, drawn to an apparatus, classified in class 425, subclass 461.
4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as applying other coatings or applying to other than pipes.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. P. O'Shea on October 25, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### *Specification*

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### *Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 5, "rapidly" is vague and indefinite as to how long it takes to solidify the coating.

Claim 7, line 1, this claim should apparently depend from claim 1 rather than claim 5, or the "thermoset"/"thermoplastic" materials appear to be contradictory. The Examiner has treated this claim as depending from claim 1 for examination purposes.

VB Claim 9, line 1, <sup>applicant</sup>~~application~~ should clarify how the extruded material is operatively connected to the length of pipe.

Claim 9, line 4, "rapidly" is vague and indefinite as to how long it takes to solidify the coating.

The other dependent claims do not cure the defects of the claims from which they depend

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 380 163 A2 (hereinafter '163).

'163 teaches a method of applying a syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

Claim 3: the cover is a thermoset material. Column 3, lines 10-20 and column 4, lines 30-35.

103 Claim 7: the cover is a thermoset material. Column 3, <sup>lines</sup>~~lines~~ 10-20 and column 4, lines 30-35. The solidifying of the thermoset is done with heat. Column 3, lines 40-45.

Claim 9: '163 teaches a method of applying a syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

103 Claim 11: the cover is a thermoset material. Column 3, <sup>lines</sup>~~lines~~ 10-20 and column 4, lines 30-35. The solidifying of the thermoset is done with heat. Column 3, lines 40-45.

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***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 as applied to claims 1, 3, 7, 9 and 11 above, and further in view of Doucet (US 4364882).

'163 teaches all the features of these claims except (1) the thermoplastic resin (claims 2, 8 and 12) and (2) the air cooling (claims 8 and 12).

However, Doucet teaches a method of applying a foam insulation to a length of pipe. Column 2, lines 15-40 and column 3, lines 5-25 and figure 1. An inner foam insulator and an outer protective cover are co-extruded around a length of pipe (co-extruded with the foam and cover). Column 2, lines 15-40 and column 3, lines 5-25 and figure 1. The cover is rapidly solidified. Column 2, lines 60-65. This retains the foam in a desired shape about the length of pipe. Column 2, lines 15-40 and 60-65, column 3, lines 5-35 and figure 1. The cover material is a thermoplastic. Column 3, lines 5-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 to use a thermoplastic as taught by Doucet with an expectation of similar results, because '163 teaches forming a three layer pipe with an inner layer, a foam intermediate

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layer and an outer layer by extrusion, and Doucet teaches that when forming a three layer pipe with an inner layer, a foam intermediate layer and an outer layer by extrusion, it is conventionally known to use a thermoplastic outer layer. It further would have been obvious to provide air cooling, because <sup>if</sup> ~~is~~ no other form of <sup>cooling</sup> ~~cooling~~ was used, the air contact after extrusion would allow the product to cool.

14. Claims 4-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 in view of Doucet as applied to claims 2, 8 and 12 above, and further in view of Francis (US 4773448).

'163 in view of Doucet teaches all the features of these claims except the water bath cooling.

However, Francis teaches a method of making a plastic pipe with a hard outer shell and an inner foam layer. Column 2, lines 5-45. Francis teaches cooling the pipe with a water bath to solidify the pipe after extrusion. Column 2, lines 25-35. The outer layer of the pipe can be made of polyvinyl chloride. Column 2, lines 33-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 in view of Doucet to use water bath cooling as taught by Francis with an expectation of similar results, because '163 in view of Doucet teaches forming a multilayer pipe by extrusion and cooling, and Francis teaches that when forming a multilayer pipe by extrusion, it is conventionally known to use a water bath to cool the extruded material.




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15. Hornbeck (US 4465449) and Conlon (US 4322260) teach making extruded pipe.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:30 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck, can be reached on (703) 308-2333.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
KATHERINE A. BAREFORD  
PRIMARY EXAMINER  
GROUP 1100-1 700